

ESTTA Tracking number: **ESTTA543817**

Filing date: **06/19/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Bamboula 8, LLC		
Entity	Limited Liability Company	Citizenship	Maryland
Address	c/o Frankfurt Kurnit Klein & Selz PC 488 Madison Avenue New York, NY 10022 UNITED STATES		

Attorney information	Mary Sotis Frankfurt Kurnit Klein & Selz PC 488 Madison Avenue New York, NY 10022 UNITED STATES pto@fkks.com Phone:212-980-0120
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Registration Subject to Cancellation

Registration No	4332360	Registration date	05/07/2013
Registrant	THE ORIGINAL WAILERS, LLC c/o AL ANDERSON, GKARMA RECORDING INTL 1239 20TH STREET NO 305 SANTA MONICA, CA 90404 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2012/04/00 First Use In Commerce: 2012/04/00 All goods and services in the class are cancelled, namely: PRERECORDED SOUND RECORDINGS, COMPACT DISCS ALL FEATURING MUSIC; DIGITAL MUSIC DOWNLOADABLE FROM THE INTERNET
Class 016. First Use: 2011/05/00 First Use In Commerce: 2011/05/00 All goods and services in the class are cancelled, namely: PAPER INSERTS AND COVERS FOR COMPACT DISCS; STATIONERY
Class 025. First Use: 2012/07/00 First Use In Commerce: 2012/07/00 All goods and services in the class are cancelled, namely: CLOTHING, NAMELY, T-SHIRTS
Class 041. First Use: 2011/05/00 First Use In Commerce: 2011/05/00 All goods and services in the class are cancelled, namely: ENTERTAINMENT SERVICES, NAMELY, LIVE PERFORMANCES BY A MUSICAL BAND; MUSICAL PERFORMANCE SERVICES, LIVE BAND PERFORMANCES, CONCERT SERVICES, ENTERTAINMENT, NAMELY, PROVIDING PODCASTS AND WEBCASTS IN THE FIELD OF MUSICAL PERFORMANCES; PRODUCTION OF FILMS, DVDS AND VIDEO TAPES OF RECORDED LIVE MUSICAL PERFORMANCES

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	4031818	Application Date	04/09/2007
Registration Date	09/27/2011	Foreign Priority Date	NONE
Word Mark	THE WAILERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/00/00 First Use In Commerce: 1973/00/00 Short-sleeved t-shirts; Shirts		

U.S. Application No.	85736051	Application Date	09/24/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE WAILERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1970/00/00 First Use In Commerce: 1970/00/00 Phonograph records featuring music; pre-recorded CDs, DVDs and audio cassettes featuring music; downloadable music files; headphones		

U.S. Application No.	85736052	Application Date	09/24/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE WAILERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 Clothing, namely, hats, baseball caps, sweatshirts, jackets, shorts, sweatpants and scarves		

U.S. Application No.	85736055	Application Date	09/24/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE WAILERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: Surf boards, body boards, skateboards, flying discs and yoga mats		

Attachments	FGKSLIB1-#484877-v5-THE_ORIGINAL_WAILERS_petition_for_cancellation.pdf(13935 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mary Sotis/
Name	Mary Sotis
Date	06/19/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BAMBOULA 8, LLC

Petitioner,

Cancellation No. _____

-v-

Reg. No. 4332360

THE ORIGINAL WAILERS, LLC

Respondent.

PETITION TO CANCEL

Petitioner, Bamboula 8, LLC (“Petitioner”), with an address at c/o Frankfurt Kurnit Klein & Selz PC, 488 Madison Avenue, New York, New York 10022, believes that it will be damaged by the continuing registration of the mark reflected in Registration No. 4,332,360 in International Classes 009, 016, 025 and 041, and hereby petitions to cancel the same.

As grounds for cancellation, it is alleged as follows:

1. Petitioner has been using the mark THE WAILERS in commerce and without interruption since at least as early as 1970 in connection with a wide variety of goods and services. Said use has been valid and continuous since the date of first use and has not been abandoned.
2. Petitioner is the owner of one trademark registration and three applications for the trademark THE WAILERS including a registration and applications in International Classes 9 and/or 25 and all of which are listed below.

3. Petitioner is the owner of Reg. No. 4,031,818 for the mark THE WAILERS in Class 25 in connection with “short-sleeved t-shirts; shirts,” which asserts a first use date of 1973.

4. Petitioner is the owner of Ser. No. 85/736,051 for the mark THE WAILERS in Class 9 in connection with “phonograph records featuring music; pre-recorded CDs, DVDs and audio cassettes featuring music; downloadable music files; headphones,” which asserts a first use date of 1970.

5. Petitioner is the owner of Ser. No. 85/736,052 for the mark THE WAILERS in Class 25 in connection with “clothing, namely, hats, baseball caps, sweatshirts, jackets, shorts, sweatpants and scarves,” which asserts a first use date of 1985.

6. Petitioner is the owner of Ser. No. 85/736,055 for the mark THE WAILERS in Class 28 in connection with “surf boards, body boards, skateboards, flying discs and yoga mats,” which goods Petitioner intends to offer in commerce.

7. Aston “Family Man” Barrett (“Barrett”) is an agent of Petitioner. In 1969, Barrett joined Bob Marley (“Marley”) as a member of the musical performance group The Wailing Wailers. In 1973 or 1974, a new incarnation of The Wailing Wailers known as Bob Marley and the Wailers formed. Barrett performed as a member of Bob Marley and the Wailers until Marley’s death in 1981. Shortly thereafter Barrett commenced performing and touring as the musical performance group The Wailers.

8. The Wailers have completed numerous world tours, playing to an estimated millions of people across the globe since the late 1960s. They have played or performed with international acts including without limitation Sting, the Fugees, Stevie Wonder and Carlos Santana. Barrett and/or Petitioner also have used the mark THE WAILERS in connection with the manufacture, distribution and sale of clothing and other merchandise directed toward the

promotion of The Wailers.

9. Through Petitioner's many years of use, advertising and promotion of its trademark THE WAILERS, the trademark THE WAILERS is symbolic of extensive good will and consumer recognition and has come to be associated by the public exclusively with Petitioner and the goods and services provided by Petitioner.

10. Respondent is the listed owner of Reg. No. 4,332,360 for the mark T.O.W. THE ORIGINAL WAILERS FEATURING AL ANDERSON in Class 9 in connection with "prerecorded sound recordings, compact discs all featuring music; digital music downloadable from the Internet," with a first use date of April 2012; in Class 16 in connection with "paper inserts and covers for compact discs; stationery," with a first use date of May 2011; in Class 25 in connection with "clothing, namely, T-shirts," with a first use date of July 2012; and in Class 41 in connection with "entertainment services, namely, live performances by a musical band; musical performance services, live band performances, concert services, entertainment, namely, providing podcasts and webcasts in the field of musical performances; production of films, DVDs and video tapes of recorded live musical performances," with a first use date of May 2011 ("Respondent's Registration"). Respondent's Registration was filed on March 10, 2011 and registered on May 7, 2013.

11. In Class 9, Petitioner's first use date of 1970 predates Respondent's first use date of April 2012 by over thirty years. Similarly, in Class 25, Petitioner's first use dates of 1973 and 1985 predate Respondent's first use date of July 2012 by several decades.

12. Petitioner's first use dates in Classes 9 and 25 also predate Respondent's first use date of May 2011 in Classes 16 and 41.

13. Respondent's website includes references to "Wailer(s)" and "Marley," with such

references presented in such a way as to create confusion as to whether Petitioner authorized Respondent's use of the mark set forth in Respondent's Registration or otherwise is affiliated or associated with Petitioner.

14. Respondent's continued use of the mark set forth in Respondent's Registration is likely to cause confusion, or to cause mistake or to deceive by suggesting that Respondent's good and services are endorsed authorized, sponsored, associated with or approved by Petitioner.

WHEREFORE, for the reasons set forth above, Petitioner requests that Registration No. 4,332,360 be cancelled.

The filing fee for the submission of this Petition to Cancel is being submitted along with the Petition.

Dated: June 19, 2013

Respectfully submitted,

B y : /Gayle Denman/
Mary Sotis
Gayle Denman
Frankfurt, Kurnit, Klein & Selz PC
488 Madison Avenue
New York, NY 10022
(212) 826-5524

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I, Matthew Bart, certify that a copy of the foregoing Petition to Cancel was served on:

Amy J. Benjamin
Goldberg Cohen, LLP
1350 Avenue of the Americas, Floor 4
New York, New York 10019-4703

By placing same with the U.S. Postal Service, via first class mail, postage pre-paid, this 19th day of June 2013.

/Matthew Bart/
Matthew Bart